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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,261	08/31/2001	Shawn J. Bradley	020976-2.00US	1974
20350	7590	01/10/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			COBY, FRANTZ	
TWO EMBARCADERO CENTER				
EIGHTH FLOOR			ART UNIT	PAPER NUMBER
SAN FRANCISCO, CA 94111-3834			2161	

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/945,261	BRADLEY ET AL.	
	Examiner	Art Unit	
	Frantz Coby	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 June 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 9-25 and 34-48 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 9-25 and 34-48 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: ____ . |

This is in response to Applicant's amendment filed on June 03, 2004 in which claims 1-8, and 26-33 were canceled; claims 9 and 34 were amended.

Status of Claims

Claims 9-25 and 34-48 are pending.

Applicant's arguments filed on the aforementioned date have been fully considered but they are not persuasive. Therefore, the rejection of claims 9-25 and 34-48 under sections 102/103 mailed on December 03, 2004 remains.

The rejection follows:

Claim Rejections - 35 USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 9-25 and 34-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Stock et al. U.S. Patent no. 6,011,858 in view of Stratford et al. US 2002/0021010 A1.

As per claim 9, Stock et al. disclose "a system adapted to receive a token, said token comprising an integrated circuit memory configured to store an image of a biometric said token adapted to provide access to an account, said system comprising: A processor configured to read the biometric image stored in the integrated circuit memory disposed in the token; wherein said processor is further configured to generate a binary number from the stored image of the biometric and in accordance with a pre-selected algorithm and a biometric sampler adapted to sample and capture an image of at least one biometric of the token holder at the location in which the system is stationed" by providing a memory card with biometric verification capability that can accommodate multiple applications, such as financial transaction application (See Stock et al. Col. 2, Line 50-Col. 3, Line 35). In addition, Stock et al. disclose the claimed limitations of wherein said memory is an integrated circuit configured to store the image of the biometric" by providing a memory card 20 which is a microprocessor-based memory card (See Stock et al. Col. 3, Lines 64-67). Stock et al. disclose the claimed

Limitations of "wherein said biometric image is a finger print image stored in the memory" (See Stock et al. Col. 4, Lines 14-27). Stock et al. disclose the claimed Limitations of "a magnetic stripe adapted to store data related to the account. Stock et al. disclose the claimed feature of "a processor configured to read the biometric image stored in the integrated circuit memory disposed in the token" by providing a memory card reader (See Stock et al. Figure 2, component 30 and corresponding text, especially Col. 5, Lines 15-29).

It is noted, however, Stock et al. did not disclose the claimed Limitations of "a biometric sample adapted to sample and capture an image" as recited in the instant claim 9. On the other hand, Stratford et al. disclose the aspect of a biometric sample adapted to sample and capture an image as shown in Stratford et al. Page 4, Section 0038.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the memory card of Stock et al. by applying the digitizing teachings of Stratford et al. into the biometric scanner processor of Stock et al. because that would have allowed user's biometric information to be captured and stored more efficiently.

As per claim 10, most of the limitations of this claim have been noted in the rejection of claim 9. In addition Stratford et al. disclose the aspect of generating a binary number from the biometric image by digitizing the biometric information (See Stratford et al. Page 3, Section 0029).

As per claim 11, most of the Limitations of this claim have been noted in the rejection of claim 10 above. In addition Stock et al. disclose the aspect of comparing two biometric information to determine a match (See Stock et al. Col. 5, Lines 42-54).

As per claim 12, most of the limitations of this claim have been noted in the rejection of claim 11. In addition Stratford et al. disclose the aspect of generating a binary number from the biometric image by digitizing the biometric information (See Stratford et al. Page 3, Section 0029).

As per claims 13-22, most of the limitations of these claims have been noted in the rejection of claim 12. In addition Stock et al. allow transactions at POS where the POS communicates the biometric information with a credit company having a second processor (See Stock et al. Col. 7, Lines 29-49). Note that the POS and the credit card company are Located at different sites. Also, Stratford et al. provide a sever for an account agency that includes a database for storing the biometric information.

As per claims 23-25, most of the limitations of these claims have been noted in the rejection of claim 12. In addition Stratford provides a display, (Figure 3, component 310)*, Stratford et al. disclose the claimed feature of a biometric sample that is a fingerprint (See Stratford et a. Page 4, Section 0038)., a magnetic read device (Figure 3, component 250).

As per claim 34, most of the limitations of this claim have been noted in the rejection of claim 33. Applicant's attention is directed to the rejection of claim 33 above. It is noted, however, Stock et al. did not disclose the claimed Limitations of "wherein said processor is further configured to generate a binary number from the stored image of the biometric and in accordance with a preselected algorithm" as recited in the instant claim 34. On the other hand, Stratford et al. disclose the aspect of generating a binary number from the stored image of the biometric by digitizing the biometric information (See Stratford et al. Page 3, Section 0029).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the memory card of Stock et al. by applying the digitizing teachings of Stratford et al. because that would have allowed user's biometric information to be stored more efficiently.

As per claim 35, most of the Limitations of this claim have been noted in the rejection of claim 34. Applicant's attention is directed to the rejection of claim 34 above. In addition, Stratford et al. disclose the claimed feature of "a biometric sample adapted to sample and capture an image" (See Stratford et a. Page 4, Section 0038).

As per claim 36, most of the limitations of this claim have been noted in the rejection of claim 35. In addition Stratford et al. disclose the aspect of generating a binary number from the biometric image by digitizing the biometric information (See Stratford et al. Page/ 3, Section 0029).

As per claim 37, most of the limitations of this claim have been noted in the rejection of claim 36. In addition Stock et al. disclose the aspect of comparing two biometric information to determine a match (See Stock et al. Col. 5, lines 42-54).

As per claim 38, most of the Limitations of this claim have been noted in the rejection of claim 36. In addition Stratford et al. disclose the aspect of generating a binary number from the biometric image by digitizing the biometric information (See Stratford et al. Page 3, Section 0029).

As per claims 39-43, most of the limitations of these claims have been noted in the rejection of claims 38. In addition, Stock et al. allow transactions at POS where the POS communicates the biometric information with a credit company having a second processor (See Stock et al. Col. 7, Lines 29-49).

Note that the POS and the credit card companies are Located at different sites. Also, Stratford et al. provides a sever for an account agency that includes a database for storing the biometric information.

As per claims 44-45, most of the Limitations of these claims have been noted in the rejection of claim 43. In addition, Stratford provides a display, (Figure 3, component 310), Stratford et al. disclose the claimed feature of a biometric sample that is a

fingerprint (See Stratford et al. Page 4, Section 0038)., a magnetic read device (Figure 3, component 250).

As per claim 46, most of the Limitations of this claim have been noted in the rejection of claim 45. Applicant's attention is directed to the rejection of claim 45 above. In addition, Stock et al. disclose the claimed Limitations of "wherein said biometric image is stored in the memory" (See Stock et al. Col. 4, Lines 14-27).

As per claim 47, most of the Limitations of this claim have been noted in the rejection of claim 46. Applicant's attention is directed to the rejection of claim 46 above. In addition, Stock et al. disclose the claimed Limitations of "wherein said biometric is a fingerprint" (See Stock et al. Col. 4, lines 14-27).

As per claim 48, most of the Limitations of this claim have been noted in the rejection of claim 47. Applicant's attention is directed to the rejection of claim 47 above. In addition, Stock et al. disclose the claimed Limitations of "wherein said memory is an integrated circuit configured to store the image of the biometric" by providing a memory card 20 which is a microprocessor-based memory card (See Stock et al. Col. 3, Lines 64-67).

Remarks

The Applicant argued, "Applicants respectfully believe certain subject matter relied on by the Examiner in the Stratford et al. publication is not by another, and thus the Stratford et al. publication is not a proper 35 U.S.C. § 102(e) reference. The Stratford et al. publication was filed on April 6, 2001, and claims priority to U.S. Provisional Patent Application No. 60/195,618, filed April 7, 2000 (the Stratford Provisional Application). The Stratford c/ al. publication includes substantial new matter that is not disclosed in the Stratford Provisional Application. Therefore, the Stratford et al. publication is not entitled to the priority date of the Stratford Provisional Application for certain subject matter disclosed therein. Applicants more fully set forth below subject matter relied on by the Examiner that Applicants believe is not entitled to the priority date of the Stratford Provisional Application". However, the Examiner disagrees with the preceding argument because both the assignee and inventive entity of the present application and the Stratford et al. reference are different. As to the argument that "The Stratford c/ al. publication includes substantial new matter that is not disclosed in the Stratford Provisional Application", the Applicant failed to point exactly what specifically subject he believes to be new matter.

The Applicant also argued, "Applicants respectfully believe certain subject matter disclosed in the Stratford et al. publication, and relied on by the Examiner, is actually Applicants' own invention. The Examiner is respectfully referred to the enclosed PCT publication WO 02/071225, filed April 6, 2001, in the name of the same inventive entity

as this U.S. patent application: Shawn J. Bradley and Richard F. Peralta (the Bradley-Peralta PCT publication). The Bradley-Peralta PCT publication is entitled to a priority date of March 1, 2001, via U.S. Patent Application No. 09/797,751, for the subject matter disclosed therein. The subject matter of the Bradley-Peralta PCT publication and the priority document are the same. The applicants for the Stratford et al. publication had access to the Bradley-Peralta U.S. Patent Application after its filing date, but prior to the U.S. tiling date of the Stratford et al. publication. The Examiner will appreciate that substantial portions of the Bradley-Peralta PCT publication appear to have been copied into, or nearly paraphrased into, the Stratford et al. publication. Applicants believe many of these copied portions are Applicants' own work." The Examiner respectfully submits that the Stratford et al. reference has an effective filing date of April 7, 2000 and the application was filed on April 06, 2001 which is also prior to the Applicant's effective filing date of August 31, 2001. Also, the Applicant did not claim priority based on the PCT date (April 6, 2001) mentioned above; therefore, this argument is mute.

The Applicant further argued, "the Office Action asserts the Stratford et al. publication discloses the aspect of generating a binary number from the stored image of the biometric by digitizing the biometric information (referring to the Stratford et al. publication, Page 3, Section 0029). This aspect is not disclosed in the Stratford et al. Provisional Application. Further, Applicants believe this disclosure is from Applicants own U.S. Patent Application No. 09/797,751, filed March 1, 2001, and thus is not by

another." The Examiner disagrees because the Applicant did not claim priority based on the PCT date (April 6, 2001) mentioned above, nor did the Applicant claimed priority based on a US Application filed on March 01, 2001. As to the line of argument that "the aspect of generating a binary number from the stored image of the biometric by digitizing the biometric not disclosed in the Stratford et al. Provisional Applicant, the Examiner respectfully submits that even the filing date of Stratford et al. US Application 09/828,265 is prior to the Applicant's effective filing date of August 31, 2001. Since the Stratford et al. reference applied disclosed the aforementioned claimed feature, that therefore, renders this argument mute.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is 571 272 4017. The examiner can normally be reached on Monday-Saturday 3:00PM-10: 30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571 272 4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frantz Coby
Primary Examiner
Art Unit 2161

January 4, 2005